

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claims 1-24 are pending, with claims 2-16 withdrawn.

I. Voicemail Summary

Applicant appreciates Examiner Reddig's phone call to Applicant's representative on May 20, 2008. Examiner Reddig left a voicemail message stating that the written description rejection in the Office Action dated March 6, 2008, would be withdrawn.

II. Claim Rejection – Written Description

Claims 1 and 17-24 are rejected under 35 U.S.C. § 112, first paragraph, for alleged non-compliance with the “written description” requirement. The Office Action cites to the Rule 132 declaration filed with the previous response on December 19, 2007, as the basis for rejecting the claims. *Id.* Applicant respectfully traverses this ground of rejection.

Claims 1 and 17-24 were amended in the previous response to omit an “about” qualifier from recitations of molecular-weight and isoelectric-point values. The Rule 132 declaration was concurrently filed to offer Dr. Robert Geztzenberg's opinion on how one skilled in the art would perceive the amended claims. Since a Rule 132 declaration cannot alter claim recitations, as such, it is incompetent as a basis for rejecting claims. Accordingly, the present reliance on the Rule 132 declaration in question is improper.

With this understanding, Applicant appreciates the aforementioned indication that the Examiner is withdrawing the pending Section 112 rejection.

III. Claim Rejection – Prior Art

Claims 1 and 17-24 are rejected for alleged obviousness over Konety *et al.*, *Journal of Urology*, 157:276 (abstract 1074) (1997) (“Konety”) in view of Harlow *et al.*, *ANTIBODIES: A LABORATORY MANUAL*, Cold Spring Harbor Laboratory Press, 1989 (“Harlow”), and

Sambrook *et al.*, MOLECULAR CLONING: A LABORATORY MANUAL, 2nd ed., Cold Spring Harbor Laboratory Press, 1989 (“Sambrook”). Office Action, pp. 3-8. Applicant respectfully traverses this ground of rejection. The Konety reference was published on March 27, 1997. Since the priority date of the present application is April 8, 1997, the Konety reference can only be considered prior art under 35 U.S.C. § 102(a).

An applicant can rebut a *prima facie* case that a reference is prior art under 35 U.S.C. § 102(a) by establishing that the reference’s disclosure is not “by others,” but derived from applicant’s own work. MPEP 2132.01. Along these lines, a “Katz” declaration is sufficient to establish that a reference is not prior art under § 102(a). *In re Katz*, 687 F.2d 450 (CCPA 1982) (holding a publication not prior art because the coauthors of the publication were merely working under the direction and supervision of applicant).

As evidenced the accompanying Rule 132 declaration, the Konety reference is not prior art because, for the teachings upon which the examiner relies, it is not a reference “by others.” That is, the declaration establishes that Robert Getzenberg, named inventor of the present application and co-author of the Konety reference, is the sole inventor of the subject matter claimed in the present application. Accordingly, the Konety reference cannot be considered prior art against the claims, and the § 103(a) rejection should be withdrawn.

CONCLUSION


Applicant submits that the present application is in condition for allowance. An early indication to this effect is solicited. Examiner Reddig is invited to contact the undersigned directly, should he feel that any issue warrants further consideration.

The Commissioner is hereby authorized to charge any additional fees, which may be required under 37 CFR §§ 1.16-1.17, and to credit any overpayment to Deposit Account No. 19-0741. Should no proper payment accompany this response, then the Commissioner is authorized to charge the unpaid amount to the same deposit account. If any extension is needed for timely acceptance of submitted papers, then Applicant hereby petitions for such extension under 37 CFR §1.136 and authorizes payment of the relevant fee(s) from the deposit account.

Respectfully submitted,

Date 5 June 2008

FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 672-5404
Facsimile: (202) 672-5399

By 
Stephen R. Snader 59,987
Stephen A. Bent
Attorney for Applicant
Registration No. 29,768